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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,203	12/10/2003	Jimmie R. Kilby		4600

7590 08/10/2006

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EXAMINER

PIERCE, WILLIAM M

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/731,203	Applicant(s) KILBY, JIMMIE R.	
	Examiner William M. Pierce	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,11 and 18-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,11,18-24 and 26-31 is/are rejected.
- 7) ☒ Claim(s) 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

William M. Pierce
Primary Examiner

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-15, 18-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Frank 6,186,892.

As to claims 1 and 18, Frank shows a game apparatus having a random number generator in fig. 4 and at (col. 6, ln. 64- col. 7, ln. 30). Since the claim does not appear to and is not being interpreted as invoking a 112, 6th paragraph means plus function limitation since it lacks an explicit use of the word "means", the function and intended use limitations fail to distinguish over the prior art. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Where claims 4 and 5 recite "means", the functional limitations of the generator selecting bingo cards and patterns is shown at col. 3, lns. 25-30 and the "diminishing awards" is shown at col. 4, lns 10-15 where Frank explicitly discloses that as "bingo numbers selected increases, the prize amounts decrease". This results in a "controllable disadvantage to the operator" where "the operator's overall percentage of retention is constant and is openly disclosed" (col 4. ln. 13). As to claims 2, 3, 6, a plurality of payout tables for a particular game format is shown at fig. 3. Depending upon the operator's retention and the version of the game a different payout table is assigned by the operator. Claims 7-17 fail to distinguish over the apparatus of the prior art since in an apparatus claim (such as instant claim 4) such must be done by reciting structure and not how the game is played. Frank is capable performing the functions recited in the above claims.

As to claims 19, 23 and 24 the random number generator is show in a game machine to be capable of generating a plurality of bingo cards (col. 3, lns. 25-29) where a player is permitted to pre-select a player pattern (abstract, ln. 3)). The random number generator is further capable of generating all 75 possible numbers as set forth at col. 3, lns. 63-68. Frank draws from every bingo number of the bingo game to match a player pattern which is considered to meet the limitations of the claim. As to claims 2, 6 and 19, Fig. 3 shows a paytable for a particular one of a plurality of formats (col. 5, ln. 48). He states that all such payout information is available to the players (col. 4, lns. 15-18). As to claims 3, 7 and 20, Frank shows the use of different paytables depending upon the type of game

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(col. 5, Ins. 38-43). As to claims 8 and 21 wagers are shown (col. 4, In. 10). Further with respect to claims 8 and 9 a player selects his own bingo card to his satisfaction (col. 3, Ins. 25-30). As to claims 10 and 22 a player may make additional wagers on each card to achieve more than one award (col. 4 In. 7).

As to claims 28-30 Frank shows the use of a communications network (col 2, In. 39). What a network is intended to do such as tracking payouts and adjusting payouts are considered function and fail to distinguish over the applied art. The intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here, computer gaming machines networked together are capable of tracking and adjusting profitability.

Claim 25 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's arguments filed 5/15/06 have been fully considered but they are not persuasive.

Applicant's remarks with respect to his sections 1-3 are noted and the grounds for rejection have been removed.

Applicant argues on his pg. 13, that Frank "does not disclose a gaming machine as envisioned by Applicant". However, applicant should not that the grounds for the rejection is made on the language of the claims and not on the "inventive concept". As set forth in the ground for rejection is how the examiner interprets each limitation in the claims to have been met by Frank. Applicant's arguments should focus on how the language of the claims patentably distinguishes them from the references.

Applicant states that Frank "does not teach generating a plurality of bingo cards" on pg. 14. However, Frank clearly shows a plurality of generated bingo cards in his fig. 2 these cards are completed at random by the players. This alone meets the language of the claims since the language of the claims does not preclude a player from randomly filling out the bingo cards. Examiner cannot offer any suggestion since traditional bingo games have preprinted bingo cards that are randomly generated. This is explicitly shown by Frank where "the cards are randomly generated such that no two are the same" (col. 1, In. 59). Frank shows above and beyond what is being claimed by applicant to now also allow a player to fill out his own card in order to give them confidence from dishonest game operators.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.


Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Pierce whose telephone number is 571-272-4414 and E-mail address is bill.pierce@USPTO.gov. The examiner can normally be reached on Monday and Friday 9:00 to 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


William Pierce
Primary Examiner